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To: U.S. Patent and Trademark Office

BOARD OF PATENT APPEALS AND INTERFERENCES

FACSIMILE No.: 571-273-0052

OUR REF.: MICRON.113C1

Application No: 09/989,563

Filed: November 19, 2001

Examiner: Anh Quan Tra

Art Unit: 2816

FROM: Irfan A. Lateef

OPERATOR: Jayne Clodfelter

DATE: September 7, 2005

No. OF PAGES: 12 (incl. cover sheet)

TIME: 3:30 p.m.

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MESSAGE: PLEASE SEE THE ATTACHED. THANK YOU.

Docket No.: MICRON.113C1

September 7, 2005

Page 1 of 1

Please Direct All Correspondence to Customer Number 20995

**TRANSMITTAL LETTER FOR PETITION FOR GRANT OF ORAL HEARING AND
REQUEST FOR ORAL HEARING**

Applicant : Sher et al.
App. No : 09/989,563
Filed : November 19, 2001
For : CLAMP CIRCUIT WITH FUSE
OPTIONS
Examiner : Anh Quan Tra
Art Unit : 2816

CERTIFICATE OF MAILING / FACSIMILE

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on date shown below, as well as faxed to Board of Patent Appeals and Interferences at Fax No. (571)-273-0052

September 7, 2005

(Date)

Irfan A. Lateef, Reg. No. 51,922

Mail Stop Board of Patent Appeals and Interferences

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

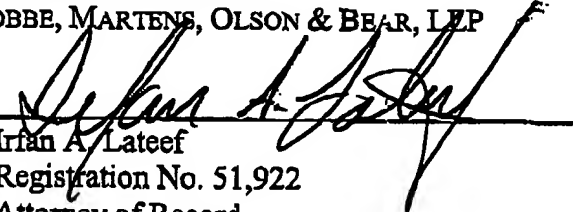
Transmitted herewith for filing in the above-identified application are the following enclosures:

- (X) *Petition for Grant of Oral Hearing* in nine (9) pages.
- (X) A check for \$130 as required for the *Petition* by 37 C.F.R. § 1.17(h) via mail.
- (X) *Request for Oral Hearing* in one (1) page.
- (X) Return postcard via mail.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: September 7, 2005

By: 
Irfan A. Lateef
Registration No. 51,922
Attorney of Record
Customer No. 20,995
(949) 760-0404

Docket No.: MICRON.113C1

September 7, 2005

Page 1 of 4

Please Direct All Correspondence to Customer Number 20995

PETITION FOR GRANT OF ORAL HEARING

Applicant	: Sher et al.
App. No	: 09/989,563
Filed	: November 19, 2001
For	: CLAMP CIRCUIT WITH FUSE OPTIONS
Examiner	: Ahn Quan Tra
Art Unit	: 2816

Mail Stop Board of Patent Appeals and Interferences
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants respectfully submit this petition under 37 C.F.R. § 1.183 in response to the Notification of Non-Compliance Regarding Oral Hearing faxed on August 24, 2005.

Summary of Relevant Facts

This application is currently under appeal. On June 2, 2003, Appellants filed a *Reply Brief* along with a transmittal letter. Appellants respectfully requested an oral hearing in this Appeal in the transmittal letter. The transmittal letter is a separate paper from the *Reply Brief*, and it plainly states "Appellants hereby request an oral hearing." A copy of the transmittal letter filed with the Reply Brief is attached as Ex. 1. This request was also accompanied by the fee set forth in 37 C.F.R. § 1.17(d).

On January 28, 2004, the Office faxed a Docketing Notice (attached as Ex. 2) to Appellants' attorneys of counsel, acknowledging that Appellants had filed a Request for Hearing in June 2003. On August 26, 2004, the Office reconfirmed that a hearing had been requested by Appellants by mailing a Notice of Hearing (attached as Ex. 3) to Appellants' attorneys of record indicating that the Appeal would be heard by the Board of Patent Appeals and Interferences on

Docket No.: MICRON.113C1

App. No.: 09/989,563

September 7, 2005

Page 2 of 4

November 18, 2004. On October 28, 2004, however, the Office mailed an Order Vacating Oral Hearing And Order Remanding to Examiner because Appellants filed an Amendment (Paper No. 20) and an Information Disclosure Statement ("IDS") (Paper No. 21). After the Examiner had entered and considered the Amendment and IDS, on March 1, 2005, the Office again mailed a Docketing Notice (attached as Ex. 4) to Appellants' attorneys of counsel, acknowledging that Appellants had filed a Request for Hearing in June 2003.

Despite three different confirmations of Appellants' request for an oral hearing, on August 24, 2005, the Office faxed a Notification of Non-Compliance Regarding Oral Hearing to Appellants' attorneys of record. The Notification indicates that Appellants' request for an oral hearing was not granted due to the Appellants' alleged failure to file the request in a separate paper, as required by 37 C.F.R. § 1.194(b).

Appellants Have Met The Separate Paper Requirement Of 37 C.F.R. § 1.194(b)

The rule in question, 37 C.F.R. § 1.194(b), states the following:

"If appellant desires an oral hearing, appellant must file, in a separate paper, a written request for such hearing accompanied by the fee set forth in § 1.17(d) within two months from the date of the examiner's answer."

The rule does not exclude transmittal letters as separate papers. Rule 1.194 merely specifies that the request for oral hearing must be made in a separate paper from the briefing.

Appellants made a good faith effort to satisfy this separate paper requirement. Appellants' transmittal letter *is* a separate paper pursuant to 37 C.F.R. § 1.194(b) and it requested an oral hearing ("Appellants hereby request an oral hearing."). Indeed, the Office accepted that transmittal letter as a separate paper requesting oral hearing on three different occasions and had even set an oral hearing date. There is no reason for the Office to stray from those previous decisions. Accordingly, the Office should reverse its decision that Appellants failed to satisfy 37 C.F.R. § 1.194(b) and set an oral hearing date.

Extraordinary Circumstances And Justice Require That The Separate Paper Requirement Be Suspended Or Waived

In the alternative, Appellants respectfully request that the requirement to *timely* file (i.e., within two months from the date of the examiner's answer, as required by 37 C.F.R. § 1.194(b))

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App. No.: 09/989,563

September 7, 2005
Page 3 of 4

a request for an oral hearing in a separate paper be waived/suspended, so that Appellants may file a new request in a separate paper. To that end, filed herewith is a request for oral hearing in a separate paper. The new request for an oral hearing is justified for two reasons.

First, Appellants are prejudiced by the Office's denial of an oral hearing. Appellants have spent a lot of time and resources on this Appeal. Had Appellants known that they would not be able to argue this Appeal at an oral hearing, then Appellants may not have pursued such an Appeal. Instead, Appellants would have proceeded differently.

For example, in the Examiner's Answer, the Examiner withdrew its rejections of claims 22-24. Appellants decided to cancel these claims ("cancelled claims") from the appeal and to pursue them in a continuation application. Had Appellants known that there would be no oral hearing regarding the remaining claims, Appellants might have accepted the cancelled claims in the Appeal and filed a continuation application to pursue the rejected claims at issue on Appeal. Because the Office lead Appellants to believe that an oral hearing would occur, Appellants tactically decided not pursue that route. Because Appellants cannot now change course with respect to how they proceed with the claims, Appellants have been unjustly prejudiced by the Office's action.

Second, an oral hearing is necessary in this case to adequately respond to the Examiner's rejections. The claimed invention is complex and relates to intricate electrical circuits. Such circuitry is subject to the much-discussed "hindsight trap," in which the invention leads an examiner to use the applicant's own disclosure as a blueprint to defeat patentability by simply piecing together circuitry used in different settings from multiple references. However, because of the complexity of the circuitry at issue and its specific use, the Examiner incorrectly characterized the circuits disclosed in the prior art and further incorrectly combined those circuits. Similarly, the Examiner did not cite any specific motivation to combine these references, but rather relied on his own conclusory assertion of a motivation to combine. Though Appellants' briefs makes these points, Appellants' arguments could be easily misunderstood and dismissed on the papers. Thus, Appellants desire an oral hearing to specifically point out, on the circuit diagram level, the deficiencies in Examiners' assertions regarding the teachings of the prior art and any motivation to combine.

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App. No.: 09/989,563

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Conclusion

The Office should accept Appellants' original request for oral hearing made in its transmittal letter accompanying the *Reply Brief*. Alternatively, because of the extraordinary circumstances and prejudice to Appellants, the Office should, in the interest of justice, waive/suspend the requirement that a request for oral hearing be timely made, accept Appellants' new request for an oral hearing filed concurrently herewith in a separate paper, and set a date for oral hearing.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: September 7, 2005

By: 

Irfan A. Lateef
Registration No. 51,922
Attorney of Record
Customer No. 20,995
(949) 760-0404

1889278
082405

PATENT

Case Docket No. MICRON.113C1

Date: June 2, 2003

Page 1

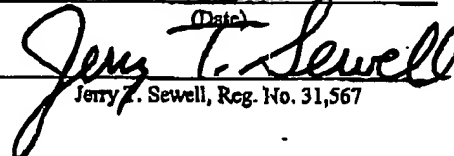
In re application of : Joseph C. Sher et al.
Appl. No. : 09/989,563
Filed : November 19, 2001
For : CLAMP CIRCUIT WITH FUSE
OPTIONS
Examiner : Anh Quan Tra
Art Unit : 2816

CERTIFICATE OF MAILING

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Assistant Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

June 2, 2003

(Date)

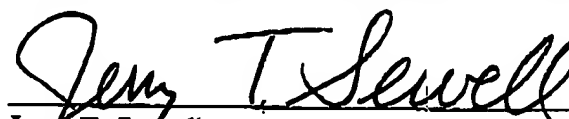

Jerry T. Sewell, Reg. No. 31,567

Mail Stop Appeal Brief-Patents
Assistant Commissioner of Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Transmitted herewith are:

- (X) Appellants' *Reply Brief* in 7 pages in triplicate;
- (X) *Amendment Accompanying Appellants' Reply Brief* in 8 pages in triplicate;
- (X) A check in the amount of \$280 to cover the request for oral hearing fee; and
- (X) A return prepaid postcard.
- (X) Appellants hereby request an oral hearing. The fee set forth in 37 C.F.R. 1.17(d) is enclosed.
- (X) Please charge any additional fees or credit overpayment to Deposit Account No. 11-1410.


Jerry T. Sewell
Registration No. 31,567
Attorney of Record
Customer No. 20,995



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

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DATE: 1/28/04

TO: Jerry T. Sewell

JAN 28 2004

A handwritten signature, possibly "JS", in dark ink.

FAX #: 1(949) 760-9502

FROM: BOARD OF PATENT APPEALS & INTERFERENCES
(703) 308-9797 (Voice)

NUMBER OF PAGES (INCLUDING TRANSMITTAL SHEET): 2

REMARKS:

**UNITED STATES PATENT AND TRADEMARK OFFICE**

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY &
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20230
www.uspto.gov

KNOBBE MARTENS OLSON & BEAR LLP,
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

Paper No: 17.
Appeal No: 2004-0589
Appellant: SHER, JOSEPH C.
Application: 09/989,563

Board of Patent Appeals and Interferences Docketing Notice

Application 09/989,563 was received from the Technology Center at the Board on December 11, 2003 and has been assigned Appeal No: 2004-0589.

A review of the file indicates that the following documents have been filed by appellant:

Appeal Brief filed on: January 10, 2003
Reply Brief filed on: June 05, 2003
Request for Hearing filed on: June 05, 2003

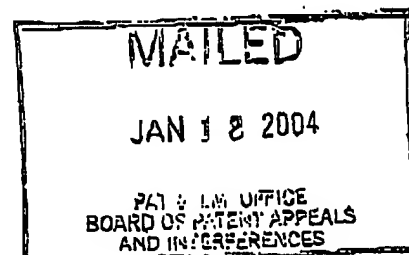
In all future communications regarding this appeal, please include both the application number and the appeal number.

The mailing address for the Board is:

**BOARD OF PATENT APPEALS AND INTERFERENCES
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VIRGINIA 22313-1450**

The facsimile number of the Board is 703-308-7952. Because of the heightened security in the Washington D.C. area, facsimile communications are recommended. Telephone inquiries can be made by calling 703-308-9797 and should be directed to a Program and Resource Administrator.

By order of the Board of Patent Appeals and Interferences





United States Patent and Trademark Office

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCESUnder Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

Paper No: 16

2004-0589

Sher, Joseph C., et al

09/989,563

A

B

Thursday, November 18, 2004

9:00 AM

5180

Knobbe, Martens, Olson & Bear
LLP
2040 Main Street
14th Floor
Irvine, CA 92614

Appeal No:

Appellant:

Application No:

Hearing Room:

Hearing Docket:

Hearing Date:

Hearing Time:

Location:

NOTICE OF HEARING

CONFIRMATION REQUIRED WITHIN TWENTY-ONE DAYS

Your attention is directed to 37 CFR § 1.194(a).

The above identified appeal will be heard by the Board of Patent Appeals and Interferences on the date indicated. Hearings will commence at the time set and as soon as the argument in one appeal is concluded, the succeeding appeal will be taken up.

The time allowed for argument is twenty minutes unless additional time is requested and permitted before the argument is commenced.

CONFIRMATION OR WAIVER OF THE HEARING IS REQUIRED.

This form must be completed below and facsimile transmitted to both: (1) the USPTO Central fax number (official copy), and (2) the Board of Patent Appeals and Interferences fax number (courtesy copy) within TWENTY-ONE (21) DAYS from the mailing date of this notice indicating confirmation or waiver of the hearing. A copy of this notice may be alternately filed by mail if facsimile is not available.

Failure to file this form within this time period will be construed as a waiver of the request for oral hearing.

37 CFR § 1.136(a) does not apply.

By order of the Board of Patent Appeals and Interferences

BPAI HEARINGS FAX No:

(703) 308-8199

USPTO Central Fax No.

(703) 872-9306

BPAI Mailing Address:

BOARD OF PATENT APPEALS AND INTERFERENCES

UNITED PATENT AND TRADEMARK OFFICE

P.O. BOX 1450

ALEXANDRIA, VIRGINIA 22313-1450

Clerk of the Board (703) 308-9797

In all communications relating to this appeal, please identify the appeal by its number.

CHECK ONE:

☒ HEARING ATTENDANCE CONFIRMED☐ HEARING ATTENDANCE WAIVED

Signature of Attorney/Agent/Appellant

Date

Registration No.

Names of other visitors expected to accompany
counsel:

AUG 30 2004

For information on visitor access to hearing rooms and security procedures at the USPTO Alexandria Campus, see
http://www.uspto.gov/web/offices/dcom/bpai/docs/contacts/contact_info.htm

**United States Patent and Trademark Office**

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

Paper No:
Appeal No: 2005-0826
Application: 09/989,563
Appellant: Joseph C. Sher et al.

Board of Patent Appeals and Interferences Docketing Notice

Application 09/989,563 was received from the Technology Center at the Board on February 07, 2005 and has been assigned Appeal No: 2005-0826.

A review of the file indicates that the following documents have been filed by appellant:

Appeal Brief filed on: January 10, 2003
Reply Brief filed on: June 05, 2003
Request for Hearing filed on: June 05, 2003

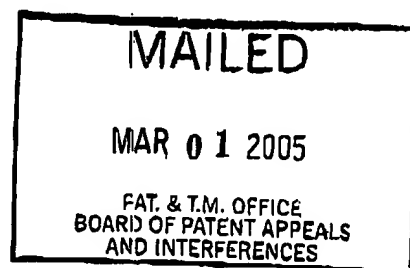
In all future communications regarding this appeal, please include both the application number and the appeal number.

The mailing address for the Board is:

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VIRGINIA 22313-1450**

The facsimile number of the Board is 571-273-0052. Because of the heightened security in the Washington D.C. area, facsimile communications are recommended. Telephone inquiries can be made by calling 571-272-9797 and should be directed to a Program and Resource Administrator.

By order of the Board of Patent Appeals and Interferences



Docket No.: MICRON.113C1

September 7, 2005

Page 1 of 1

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REQUEST FOR ORAL HEARING**FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

Applicant	: Sher et al.
App. No	: 09/989,563
Filed	: November 19, 2001
For	: CLAMP CIRCUIT WITH FUSE OPTIONS
Examiner	: Anh Quan Tra
Art Unit	: 2816

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.194(b), Appellant hereby requests an Oral Hearing before the Board of Patent Appeals and Interferences of the above-identified application.

A check in the amount of \$280 to cover this request for oral hearing was already submitted with Appellants' *Reply Brief*. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: September 7, 2005

By: 

Irfan A. Lateef

Registration No. 51,922

Attorney of Record

Customer No. 20,995

(415) 954-4114